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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,816	05/15/2001	Andrew C. Braisted	9491-053-27 DIV	1579

7590

01/02/2003

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EXAMINER

DELACROIX MUIRHEI; CYBILLE

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/854,816

**Applicant(s)**

BRAISTED ET AL.

**Examiner**

Cybille Delacroix-Muirheid

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

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### **DETAILED ACTION**

The following is responsive to Applicant's election/remarks received Nov. 1, 2002.

Upon further consideration of the pending claims, the following supplemental restriction requirement is being submitted.

The previous restriction requirement set forth in the office action mailed Oct. 1, 2002 is withdrawn in view of the following new restriction/election.

Due to the complex nature of the claims, no request for an oral election is being made. Please see MPEP 812.01.

### ***Supplemental Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-3, drawn to a method of making a constrained helical peptide, classified in class 530, subclass 333+.
  - II. Claims 4-5, 8, 9, 11-12, 14-15 drawn to a compound, classified in class 530, subclass 350+.
  - III. Claims 6-7 drawn to a constrained helical peptide, classified in class 530, subclass 350+.
  - IV. Claims 10, 11, 12, 14, 15, drawn to a compound comprising a constrained helical peptide and methods of use, classified in class 530, subclass 324+.
  - V. Claim 13, drawn to an antibody, classified in class 530, subclass 387.9.

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VI. Claims 14-15, drawn to a method for treating or preventing HIV, classified in class 514, subclass 2+.

VII. Claim 16, drawn to a vaccine, classified in class 424, subclass 184.1+.

2. Groups I-VII are patentably distinct. Group I is drawn to a distinct method of synthesizing constrained helical peptides. Group II is drawn to a compound with a defined structure which is not required by the compounds in Groups III and IV; Groups II and IV are distinct because the disclosed compounds are structurally and chemically distinct and one compound would not suggest substitution with the other. Furthermore, the compounds of claim 10 in Group IV do not require the specific structures represented by Formulas in Group II. Groups III and IV are distinct because the compounds of Group III do not require the structural or sequential characteristics of Group IV and the search for one is not required for the other. Groups V and VII claim structurally distinct compounds/compositions. Group VI is drawn to a method of treating or preventing HIV in a mammal comprising administering the compounds of claims 8 or 10; however, Group VI is distinct from Groups II or IV because Group VI's claimed method can be practiced with another materially different compound such as a protease inhibitor. Finally, the methods of Group I and VI have different modes of operation, different functions, or different effects.

3. Because these inventions are distinct for the reasons given above and the search required for one Group is not required for another, restriction for examination purposes as indicated is proper.

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4. This application contains claims directed to the following patentably distinct species of the claimed invention: **(GROUP II and VI)**; a compound selected from Formula (1); Formula (6); Formula (11); Formula (16) and further comprising the consensus or homolog sequences set forth in Figures 16A-16G. Applicant is respectfully requested to elect a single formula as well as a single species of consensus or homolog sequence.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 4, 10 and 14 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cybille Delacroix-Muirheid whose telephone number is (703) 306-3227. The examiner can normally be reached on Tue-Fri from 8:30 to 6:00. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

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CDM



Dec. 30, 2002



Cybille Delacroix-Muirheid  
Patent Examiner Group 1600